## REMARKS

The Examiner maintains the rejections of pending claims 1-33. Specifically, claims 1-6, 10-15 and 19-24 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Raman, U.S. Patent No. 6,134,598 (hereinafter "Raman") in view of Klein et al., U.S. Patent No. 6,178,426 (hereinafter "Klein"). Additionally, claims 7-9, 16-18, 25-27 and 31-33 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Raman in view of Klein, and further in view of Guck, U.S. Patent No. 5,911,776 (hereinafter "Guck"). In further support of the prior rejection, claims 28-30 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Raman, Klein and Guck, and further in view of Beckwith et al., U.S. Patent No. 6,330,598 (hereinafter "Beckwith"). Applicants traverse these claim rejections as follows. Consequently, Applicants respectfully request the Examiner to reconsider the aforementioned grounds of rejection.

### A. Claims 1-6, 10-15 and 19-24 are patentable over Raman and Klein.

Claims 1, 10 and 19

Claim 1 provides a method of accessing data at a server computer from a client computer connected via a network, the data being stored on a data storage device connected to the server computer. The method of claim 1 includes, "at the server computer, receiving a request for data from the client computer; determining whether the client computer can access the data in its stored form; when it is determined that the client computer cannot access the data in its stored

form, converting the data into a form that the client computer can access; and returning a locator to the client computer for locating the converted data" (*see also* claims 10 and 19).

The Examiner alleges that Raman teaches all of these features, except returning a locator to the client computer for locating the converted data (Raman: Abstract; col. 1, line 10 to col. 2, line 62; and col. 3, lines 15-37). Furthermore, the Examiner alleges that Klein makes up for this acknowledged deficiency of Raman by teaching returning a URL to the client for the client to retrieve requested data from the appropriate location (Klein: col. 10, lines 45-65).

Applicants respectfully submit that a reasonable combination of Raman and Klein, if any, would not render claims 1, 10 or 19 obvious. Raman is fundamentally different from the method of claim 1 (*see also* claims 10 and 19).

For example and not by way of limitation, according to the claimed invention, a client computer need only provide a request for data to receive the data in a format usable by the client computer (*see* claims 1, 10 and 19). In the claimed invention, it is at the server computer that the request for data from the computer is received and processed. As recited in claim 1, the steps of "determining whether the client computer can access the data in its stored form [and] when it is determined that the client computer cannot access the data in its stored form, converting the data [at the server] into a form that the client computer can access" are performed "at the server computer" (*see also* claims 10 and 19).

Conversely, Raman describes performing a particular function on data, wherein a client computer itself initially determines in what first format the data is represented (Raman: col. 6.,

lines 1-11; and claim 1). Once the first format is determined, it is used to search the client computer for a first resource for performing the function on the data in the first format (Raman: col. 5, lines 33-43; and claim 1). If the search of the client computer fails to yield a first resource for performing the function on the data in the first format, the client computer is then searched for a second resource for performing the function on the data in any other, second data format (Raman: col. 5, lines 44-50; and claim 1). Upon finding such a second resource, the client computer itself searches for a parsing server that can parse the data from the first format to the second format (Raman: col. 5, lines 44-53; and claim 1). Once a suitable parsing server has been identified, the data is transmitted (*e.g.*, from the client computer) to the identified parsing server to be parsed into data in the second format (Raman: col. 6, lines 12-46; and claims 1-2). Then, the data parsed into the second format is received on the client computer, wherein the client computer uses the second resource on the client computer to perform the function on the parsed data (Raman: col. 6, lines 58-64; and claim 1).

Thus, in Raman, the client computer itself determines in what format the data is represented and whether the client has the resources to perform a desired function on the data in its current format (Raman: Abstract). If the client computer does not have the resources to perform the desired function on the data in its current format, but the client computer does have the resources to perform the desired function on the data in a different format, the client computer searches for a parsing server that can convert the data from the first format to the second format (*Id.*). Upon locating a suitable parsing server, the data to be converted is transmitted to the parsing server and converted into the second format (*Id.*). Finally, the

converted data is sent from the parsing server to the client computer, whereby the desired function can be performed on the converted data (*Id.*).

Accordingly, the system described in Raman is fundamentally different from the claimed invention. For example and not by way of limitation, in the claimed invention, if a request for an image file named "abc" as a .gif file is received at the server, but the image file "abc" is stored at the server as a .jpg file, the stored file abc.jpg is converted to a file abc.gif that is accessible by the requesting client.

Conversely, in Raman, to perform a particular function (*e.g.*, printing a file) on data (*e.g.*, file xyz), the client computer first determines in what format the data is represented, for example, as a .pdf file. If it is determined that the client computer cannot print the file xyz when it is in a .pdf format, it is determined whether the client computer can print the file xyz when it is in another format. Should the client computer be able to print the file xyz when it is in a another format, for example, when it is in a .doc format, the client computer searches for a parsing server that can convert the data from the unusable format into the usable format. In Raman, once such a parsing server is identified, the file xyz.pdf is transmitted to the identified parsing server in order to have the unusable file xyz.pdf converted into a unusable file xyz.doc. Then, the parsed file, xyz.doc, is sent from the parsing server to the client computer to be printed.

Consequently, the client-oriented system of Raman is considerably more complex than the claimed invention. For example, Raman requires that each client computer system maintain numerous data structures in order to have data parsed from an unusable format into a format

usable by the facilities of the client computer (Raman: Figs. 1b and 2; and col. 4, line 43 to col. 5, line 6).

Furthermore, Raman does not teach or suggest "at the server computer, . . . determining whether the client computer can access the data in its stored form", as recited in claim 1 (*see also* claims 10 and 19). To the contrary, by the time the client computer sends a PARSE_AND_TRANSMIT message to the parsing server, requesting parsing of data from a first unusable format into a second usable format, the client computer has, as noted above, already determined (at the client computer) that the first (*i.e.*, original) format of the data is unusable to the client computer (Raman: col. 5, lines 44-53; col. 6, lines 12-28; and claim 1). Indeed, if the client computer hadn't already made this determination, it would not be contacting the parsing server (Raman: col. 5, lines 37-43).

In view of the above, Raman fails to teach or suggest the method of claim 1, including the steps of "at the server computer, receiving a request for data from the client computer; determining whether the client computer can access the data in its stored form; when it is determined that the client computer cannot access the data in its stored form, converting the data into a form that the client computer can access" (*see also* claims 10 and 19).

Further still, the Examiner acknowledges that Raman fails to teach or suggest the step of "at the server computer, . . . returning a locator to the client computer for locating the converted data", as recited in claim 1 (*see also* claims 10 and 19). Instead, the Examiner alleges that Klein makes up for this acknowledged deficiency of Raman (*citing* Klein: col. 10, lines 45-65).

Klein relates to an apparatus and a method for capturing data into a markup language data entry form (Klein: col. 1, lines 5-10). For example, data read by a magnetic stripe reader (MSR) can be provided to an HTML form that is designed to accept the data (Klein: col. 10, lines 40-42). In Klein, a CGI application performs processing on the data and then forwards the results to a server (Klein: col. 10, lines 56-58). If the web page resides on the same server, the server will deliver the web page to a client browser (Klein: col. 10, lines 58-60). However, if the web page resides on a different server, the current server returns a URL to the client browser, which in turn sends a request to the correct server for the page (Klein: col. 10, lines 60-64).

Applicants respectfully submit that the Examiner fails to provide a reasonable suggestion or motivation (absent impermissible hindsight) from the references themselves or the knowledge generally available to one of ordinary skill in the art at the time of the invention for combining Raman and Klein.

As noted above, Klein merely describes that if the results returned from the CGI application and a web page for formatting the results reside on the same server, then the server delivers the actual web page to the client browser. Conversely, if the web page resides on a server different from the current server to which the CGI application forwards its results, then the current server returns a URL to the client browser, which can use the URL to request the web page from the correct server (Klein: col. 10, lines 56-63).

In Raman, a parsing sever that is responding to a PARSE_AND_TRANSMIT message, would always have the converted data, since it was actually converted at/by the parsing server.

Consequently, a PARSE_AND_TRANSMIT_RESPONSE message being sent from the parsing server to the client computer always includes the actual parsed data, *e.g.*, in Data field 400 (Raman: Fig. 7b). Thus, it would not have been obvious to one of ordinary skill in the art to modify Raman so that a URL is returned, as described in Klein, because the situation described in Klein (*i.e.*, data to be returned to the client being located on a different server) would not arise in Raman.

Furthermore, the Examiner's purported motivation that such a combination "would have improved a load on the server by returning the locator to the client for the client locating the stored data in other storage such as [a] database and thereby decreased the number of steps of delivering data via the server which in turn will reduce the total traffics in the network" is flawed (*see* Office Action, page 3).

For example, even assuming *arguendo* that a combination of Raman and Klein would successfully allow a URL to be returned after a parsing server has converted the data from a first format into a second format, the data would still need to be requested and retrieved by the client computer system such that the desired function could be performed on the converted data (Raman: Abstract; claim 1). Consequently, requiring the client computer to request the converted data from the parsing server, as opposed to directly delivering the converted data from the parsing server to the client computer, would not result in a reduction of the total traffics in the network 1a of Raman as alleged by the Examiner. Therefore, absent impermissible hindsight, it would not have been obvious to one of ordinary skill in the art at the time of Applicants' invention to combine Raman and Klein as alleged by the Examiner.

Further still, in response to the Examiner's statements in the Office Action on pages 7 and 8, including that there is no requirement that a motivation to make a modification be expressly articulated, the Examiner is reminded that the burden is initially on the Examiner to establish a *prima facie* case of obviousness (*see* MPEP § 2142). Accordingly, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings (*see* MPEP § 2143). In particular, the teaching or suggestion to make the claimed combination and a reasonable expectation of success must both be found in the prior art, not in Applicants' disclosure (*Id.*; *citing In re Vaeck*, 947 F.2d 488; 20 U.S.P.Q. 2d 1438 (Fed. Cir. 1991)).

For at least the above exemplary reasons, claims 1, 10 and 19 are not rendered obvious by a reasonable combination, if any, of Raman and Klein.

Claims 2-6, 11-15 and 20-24

Claims 2-6, 11-15 and 20-24 are patentable at least by virtue of their dependency, as well as the additional features recited therein.

For example and not by way of limitation, claim 4 recites the step of "before the step of retrieving the file, . . . determining whether the file identifier is valid" (*see also* claims 13 and 22). The Examiner continues to allege that Raman describes this step at col. 5, lines 18-36. To the contrary, Raman describes the steps taken by a client system in performing a given function on a resource (*i.e.*, data) specified by a URL (Raman: col. 5, lines 25-65; Fig. 5). Indeed, in

Raman, even if the URL contains an extension that does not match any of the Extension Descriptors in the TheExtensionList, it is not considered invalid (Raman: col. 6, lines 7-11). Thus Raman fails to teach or suggest any determination of whether a file identifier is valid.

Instead, Raman merely describes determining whether a client computer has a resource for performing a particular function on the data in a first format (Raman: claim 1). Further still, Raman fails to teach or suggest that even this determination is made "before the step of retrieving the file [*i.e.*, data]", as recited in claim 4 (*see also* claims 13 and 22). Consequently, Raman fails to teach or suggest any determination as to whether a file identifier is valid before attempting to retrieve the file.

**B. Claims 7-9, 16-18, 25-27 and 31-33 are patentable over Raman, Klein and Guck.**

Guck fails to make up for the deficiencies of Raman and Klein, described above with respect to claims 1, 10 and 19. Thus, claims 7-9, 16-18, 25-27 and 31-33 are not rendered obvious by a reasonable combination, if any, of Raman, Klein and Guck, at least by virtue of their dependency.

**C. Claims 28-30 are patentable over Raman, Klein, Guck and Beckwith.**

Guck and Beckwith (alone or in combination) fail to make up for the deficiencies of Raman and Klein, described above with respect to claims 1, 10 and 19. Thus, claims 28-30 are not rendered obvious by a reasonable combination, if any, of Raman, Klein, Guck and Beckwith, at least by virtue of their dependency.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

Billy Carter Raulerson
Registration No. 52,156

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE
23373
CUSTOMER NUMBER

Date: January 8, 2004